

REMARKS

These remarks are in response to the non-final Office Action dated October 14, 2008 (referred to hereinafter as “the Office Action”). Claims 1-51 are currently pending in the application. Claims 1-51 stand rejected. Applicant has amended no claims, and respectfully requests reconsideration of the application as presented herein. No new matter has been added.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on European Pat. App. EP 1 024 661 A2 to Gagnon *et al.*, U.S. Patent No. 6,310,661 to Arsenault and U.S. Patent No. 6,990,680 to Wugofski

Claims 1-7, 9-16, 18-20, 22-27, 29-36, 39-44, and 46-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over by European Patent No. EP 1 024 661 A2 to Gagnon *et al.* (“Gagnon”) in view of U.S. Patent No. 6,310,661 to Arsenault (“Arsenault”) and further in view of U.S. Patent No. 6,990,680 to Wugofski (“Wugofski”). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144.

Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Furthermore, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, *teaches away from the claimed invention*. In *re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Furthermore, *if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification*. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-7, 9-16, 18-20, 22-27, 29-36, 39-44, and 46-50 are improper because there is no suggestion or motivation to make the proposed modification since the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose.

Modification of Reference Renders Reference Unsatisfactory for Intended Purpose

Applicant respectfully submits that Gagnon and Arsenault and Wugofski, in any proper combination, do not teach or suggest “[transmitting/receiving/multiplexing/determining] [information/message/protocol] in-band [with/corresponding to] the broadcast [session/stream]” and the “information [] including physical channel parameters” for “processing [a] broadcast [channel/session/stream]” as claimed in Applicant’s independent claims 1, 3, 5, 7, 12, 19, 23, 34, 39, and 47.

The Office Action alleges:

It would have been obvious for one of ordinary skill in the art at the time of the invention, when presented with the work of Wugofski, to combine transmitting broadcast overhead information in-band with a broadcast stream, as disclosed by Wugofski, with the system and method of Gagnon et al. and Arsenault, with the motivation being to create more efficient bandwidth usage since no bandwidth channels need to be assigned to exclusively include broadcast control information. (Office Action, p. 13)

However, according to M.P.E.P. § 2143.01:

If [a] proposed modification would render the prior art invention being modified *unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification*. In *re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984; emphasis added).

According to the present rejection, an attempt is made to modify Gagnon's out-of-band "broadcast overhead information (e.g., SDP+ record) by modifying the "broadcast overhead information (e.g., SDP+ record) to be *in-band* as allegedly taught by Wugofski. (Office Action, pp. 12-13). However, modifying Gagnon's out-of-band SDP+ record to be in-band with the broadcast stream as allegedly taught by Wugofski renders Gagnon "unsatisfactory for its intended purpose" of allowing the "broadcast overhead information (e.g., SDP+ record) to precede any content allowing a user to determine whether the user desires to burden the channel by selecting to receive the content at all.

Specifically, the Office Action cites Gagnon for teaching:

Gagnon et al. also discloses that the broadcast overhead information provides information to a receiver for processing the broadcast session (See page 16 paragraph 84 of Gagnon et al. for reference to SDP+ records ... which are all types of information used to process the broadcast session by the receiver station 106). (Office Action, p. 3).

Accordingly, Gagnon is clear about the *purpose* of such SDP+ records which are alleged by the Office Action to teach Applicant's "information used to process the broadcast session."

Specifically, Gagnon's disclosed purposes include:

Each download service (e.g., each webcast, each software download, etc.) has its own ***SDP+ record***, which is broadcast to all subscribers *to inform them of the information that is available for download*. (Gagnon, [0085], lines 7-10; emphasis added).

SDP+ records also *allow* users *to pre-select* download content from descriptions of the content, then filter for that information as it arrives in the one-way data stream of the DTH system 100. (Gagnon, [0086], lines 1-4; emphasis added).

Clearly, the purpose of Gagnon's "broadcast overhead information" (e.g., Gagnon's SDP+ record) is to provide information to a user *for selection or non-selection in advance* of broadcasting the respective content. Therefore, any modification of Gagnon by Wugofski of placing Gagnon's "broadcast overhead information (e.g., SDP+ record)" *in-band* with Gagnon's broadcast content would deny the Gagnon invention of its intended purpose, namely, "*to inform [users] of the information that is available for download*" (Gagnon, [0085], lines 7-10) or "*allow users to pre-select download content from descriptions of the content, then filter for that information as it arrives in the one-way data stream*" (Gagnon, [0086], lines 1-4).

Therefore, the assertion in the Office Action of an “obvious” modification to “combine transmitting broadcast overhead information in-band with a broadcast stream, as disclosed by Wugofski, with the system and method of Gagnon et al. and Arsenault” (Office Action, p. 13) would result in Gagnon being unsatisfactory for its intended purpose since Gagnon’s users would have no need “*to [be] inform[ed] [] of the information that is available for download*” (Gagnon, [0085], lines 7-10) or “*to pre-select download content from descriptions of the content*” (Gagnon, [0086], lines 1-4), since the broadcast content would already be concurrently transmitted.

Therefore, since the alleged modifications to Gagnon by Wugofski would render Gagnon unsatisfactory for its intended purpose of providing information to a user *for selection or non-selection in advance* of broadcast content, the *prima facie* case for obviousness under 35 U.S.C. § 103 has been rebutted. Accordingly, the rejections are improper and must be withdrawn.

For these reasons, Applicant submits that the 35 U.S.C. § 103 rejections of claims 1, 3, 5, 7, 12, 19, 23, 34, 39, and 47 are improper and respectfully requests that the rejections be withdrawn.

Obviousness Rejection Based on Gagnon in view of Arsenault and Wugofski and further in view of U.S. Patent No. 6,032,197 to Birdwell et al.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gagnon in view of Arsenault and Wugofski and further in view of U.S. Patent No. 6,032,197 to Birdwell et al. (“Birdwell”). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claim 7 precludes a rejection of claim 8 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant respectfully requests withdrawal of the rejection to independent claim 7 and claim 8 which depends therefrom.

Obviousness Rejection Based on Gagnon in view of Arsenault and Wugofski and further in view of European Pat. No. EP1024661A2 to Rustad et al.

Claims 17, 28, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gagnon in view of Arsenault and Wugofski and further in view of U.S. Patent No. 6,775,303 to Rustad *et al.* ("Rustad"). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claims 12, 23, 39 preclude a rejection of claims 17, 28, 45 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to independent claims 12, 23, 39 and claim 17, 28, 45 which depend therefrom.

Obviousness Rejection Based on Gagnon in view of Arsenault and Wugofski and further in view of U.S. Patent No. 6,580,756 to Matsui *et al.*

Claims 21, 37, 38, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gagnon in view of Arsenault and Wugofski and further in view of U.S. Patent No. 6,580,756 to Matsui *et al.* ("Matsui"). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claims 19, 34, 47 preclude a rejection of claims 21, 37, 38, and 51 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant respectfully requests withdrawal of the rejection to independent claims 19, 34, 47 and claim 21, 37, 38, and 51 which depend therefrom.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is cordially invited to telephone the undersigned at the number provided below.

The Commissioner is authorized to charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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